

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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In re Application of

Confirmation No. 9462

Peter Hofbauer, et al.

Attorney Docket No. APT-2.009.PCT.US

Serial No.: 10/560,147

Art Unit: 2834

Filed: December 9, 2005

Examiner: Julio C. Gonzalez

For: RING GENERATOR

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450**SUBSTANCE OF THE INTERVIEW**

Applicant called Examiner Gonzalez on April 28, 2009 to request an interview. Applicant discussed a few grounds to be raised in the interview including the propriety of the withdrawal of claims 22-42. Although applicant asserted a belief that the withdrawal was improper and discussed the legal test for a restriction, no detailed arguments were advanced and no claims were discussed.

INTERVIEW AGENDA

Applicant requested an interview with Examiner Gonzalez and Supervisor Leung where Applicant could present detailed arguments and discuss the specifics of the claims. Supervisor Leung requested an interview agenda prior to scheduling an interview to allow adequate preparation for discussion.

Applicant notes that the shortened statutory period ends on 5/23 and would appreciate conducting an interview before then if possible. Applicant wishes to raise the following points in the interview:

1. Rejection of claim 14 is based on incorrect scientific fact that an electrical generator must include "a current conducting ... stator" to operate.
 - a. Claim 14 recites "a current conducting ... stator."

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Serial No. 10/560,147

- b. Office Action of October 14, 2008 rejected claim 14 based on a generator
 - c. Applicant responded on January 7, 2009 pointing out that a generator need not incorporate "a current conducting ... stator."
 - d. Office Action of February 23, 2009 finally rejected claim 14, realleging a generator must include a stator and providing evidence in Electrical Power.
 - e. Applicant responded April 23, 2009 pointing out numerous examples showing this was scientifically inaccurate: Electrical Power actually disclosed that a current conducting stator was not required, additional evidence from Introduction to Electrodynamics showed a generator without a current conducting stator and described Michael Faraday's 1831 experiments, cited two United States Patents to statorless generators.
 - f. "Office personnel should consider all rebuttal arguments and evidence presented by applicants." MPEP 2145.
 - g. Advisory Action of May 1, 2009 merely alleged claim 14 was "too broad" and did not consider Applicant's arguments and evidence.
 - h. Applicant notes that claim 14 has not been amended other than to place it in independent form, thus the rejections of claim 14 cannot be necessitated by amendment.
 - i. Accordingly, Applicant requests that the Office Action of February 23, 2009 be withdrawn and a new non-final action issued.
2. Applicant raised additional grounds in the April 23, 2009 response, which were not addressed in the Advisory Action of May 1, 2009.
- a. Applicant argued that the proposed case for claims 10, 12, and 13 would render the prior art unsatisfactory for its intended purpose.


- b. Applicant pointed out that the proposed case for claim 12 did not provide a clear articulation of why the claimed invention would be obvious.
 - c. Applicant pointed out that the proposed modification for claim 15 would merely decrease the output power without providing any benefit.
 - d. Advisory Action of May 1, 2009 merely alleged these claims were "too broad" and did not consider Applicant's arguments.
 - e. "Office personnel should consider all rebuttal arguments and evidence presented by applicants." MPEP 2145.
 - f. Accordingly, Applicant requests that the Office Action of February 23, 2009 be withdrawn and a new Office Action issued.
3. Applicant traverses the propriety of restricting claims 22-42.
- a. The Office Action of February 23, 2009 withdrew claims 22-42 as drawn to an independent and distinct invention.
 - b. The Office Action merely identified a set of elements and alleged the two inventions were independent or distinct.
 - c. There are two criteria for a proper requirement for restriction between patentably distinct inventions: (A) The inventions must be independent or distinct as claimed; and (B) There would be a serious burden on the examiner if restriction is not required. MPEP 803.
 - d. "The term "independent" (i.e., unrelated) means that there is no disclosed relationship between the two or more inventions claimed, that is, they are unconnected in design, operation, and effect. MPEP 802.01(I)
 - i. Do claims 10 and 22 have similar design, operation, and effect?
 - e. "Related inventions are distinct if the inventions as claimed are not connected in at least one of design, operation, or effect and wherein at

least one invention is PATENTABLE OVER THE OTHER." (emphasis in original) MPEP 802.01(II).

- i. Claims 10 and 22 have similar design, operation, and effect.
- ii. For example, claim 22 covers a "current conducting element ... fixedly disposed in relation to the first rotatable hub."
- iii. Claim 10 recites "a current conducting element disposed in fixed relation to the ring."
- iv. Is every listed limitation a patentable distinction over the other?
- v. Was this limitation improperly cited?
- f. "Where the claims of an application define the same essential characteristics of a single disclosed embodiment of an invention, restriction therebetween should never be required." MPEP 806.03.
 - i. Do claims 10 and 22 define the same essential characteristics of the embodiment shown in Figure 1?
- g. The restriction of these claims is improper and Applicant requests that the withdrawal of claims 22-42 be withdrawn and these claims examined.

Respectfully submitted,

Date: 19 May 2009


David Copeland
Registration No. 56,176
P. O. Box 2200
Hillsboro, Oregon 97123
Telephone: (503) 844-9009
Facsimile: (503) 296-2172
email: mail@ganzlaw.com